

Docket No.: SA9-98-050 (12780.315)

Patent

REMARKS

It is our understanding that claims 3-16 and 18-22 remain pending in this application. We proceed now with reference specifically to the numbered items in the Action.

Items 1-5, 7, and 12-13:

These appear informational in nature and are understood to require no reply.

Item 6 (§ 101 rejection of claims 3-10):

Claims 3-10 are rejected as being directed to non-statutory subject matter. Responsive to the Examiner's suggestion in the Action, claim 3 is herein amended. Claims 4-10 depend from claim 3 and are similarly effected. No new subject matter is added by this amendment.

Item 8 (§ 103(a) rejections, 1 of 4):

Claims 3, 5-6, 11, 16, and 18-22 are rejected as being unpatentable (obvious) over Motoyama in view of in view of Fukumochi and Lakritz.

Respectfully this is error. As has long been established:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP §2142

We respectfully submit that the prima facie case for obviousness has not been met here because the rejection fails to meet all three of the above criteria.

In regard to claim 3, the Action states:

Motoyama teaches a HTML document page translated using a resource dictionary database (file) containing translated words and phrases for replacing variables (Motoyama column 4 lines 14-23, column 5 lines 41-46, column 6 lines 41-55; compare with claim 3 "a plurality of resource file containing data for replacing said replacement variable,").

Respectfully, this is misunderstanding or mischaracterization. Motoyama nowhere uses any of the phrases "resource dictionary database," "resource dictionary," "dictionary database,"

Docket No.: SA9-98-050 (12780.315)

Patent

or any variants of them. Motoyama also nowhere uses the term “*variable*” or any variants of it. As noted, however, claim 3 does use a “*resource file*” and a “*variable*.” It would therefore appear that 20/20 hindsight based on Applicant’s disclosure is the source of this misunderstanding or mischaracterization.

The cite to col. 4, ln. 14-23 merely teaches formatting and distinguishing sections of a document. As such, this does not even support the assertion and is irrelevant here. The cite to col. 5, ln. 41-46 states “*It is not critical that every tag or data be translated*” This cannot be reconciled with the “*always*” occurring variable replacement in claim 3. The cite to col. 6, ln. 41-55 teaches the use of dictionaries and rule databases, but these are not elements in claim 3.

The Action continues:

Motoyama teaches dictionary resource files indicative of various languages for web page variable replacement (Motoyama column 6 lines 20-24; compare with claim 3 “said replacement variable being selectively replaced by data from a selected one of said resource files, each of the plurality....selected one of said resource files.”, and “predefined passage of text”).

Respectfully, again, Motoyama does not teach “*resource files*” or “*replacement variables*” as such apply to claim 3, Motoyama teaches dictionaries and rule databases needed to use those dictionaries. At col. 6, ln. 20-24 Motoyama simply states “*FIG. 4 illustrates an exemplary ... English-Japanese/Japanese-English Dictionary 70 having four separate sections including a copier dictionary 72, a scanner dictionary 84, a printer dictionary 86, and a general English and Japanese vocabulary dictionary 88.*” Thus, Motoyama here teaches a dictionary having four different sections, covering three specific different situations (copies, scanners, and printers being the subject) and a general vocabulary dictionary covering other situations. This (and the rest of the cited paragraph, *id.*, ln. 20-40) cannot be reconciled with claim 3, which recites:

a plurality of resource files containing data for replacing said replacement variable, ... each ... containing an idiomatically-correct predefined passage of text in a different language such that said replacement variable will always be replaced with a respective said passage of text governed by the selection of a particular one of said resource files. (emphasis added)

Here, a single passage of text for replacement of the replacement variable exists in any given resource file. This is clearly not a dictionary, and especially not one like Motoyama’s, having four different situational-specific sections to choose definitions from. In sum, Motoyama does

Docket No.: SA9-98-050 (12780.315)

Patent

not teach or reasonably suggest multiple elements that it has been relied up on for, and a prima facie case for obviousness has not been stated.

Furthermore, at col. 6, ln. 20-55 Motoyama actually supports a finding that claim 3 is not obvious. By employing its complex scheme of dictionaries and rule databases, Motoyama is clearly using a different principle of operation. Modifications or combinations of prior art that change a principle of operation are not obvious. See e.g., MPEP 2143.01 and the case law cited therein.

The Action next states:

Motoyama does not specifically teach resource files including idiomatically-correct predefined text passages. However, Fukumochi teaches a translation system using a dictionary containing idioms of a language as applied to translation from one language to another (Fukumochi Abstract, column 4 lines 64-67 to column 5 lines 1-11; compare with claim 3 "idiomatically-correct"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the dictionary idioms of Fukumochi to the resource files of Motoyama, providing Motoyama the advantage of idioms within its resource files, for accurately translating specialized phrases from one language (and culture) to another.

The Action here contradicts itself. Having earlier stated that "*Motoyama teaches dictionary resource files*" it now states that "*Motoyama does not specifically teach resource files.*" Applicant asks for a clear statement for the record to permit us a reasonable opportunity to reply to the rejection. In a responsive spirit, however, we provide the following remarks.

Respectfully, the conclusion drawn in the Action here is also error. As the Action itself states, "*Fukumochi teaches a translation system using a dictionary containing idioms [plural] of a language*" However, the resource files in claim 3 each contain only one idiomatically-correct predefined passage of text (singular) with which to replace a replacement variable in a template. These resource files accordingly do not contain idioms (plural) to choose from.

The Action then states, that "*It would have been obvious ... to apply the idioms of Fukumochi to resource files of Motoyama, providing Motoyama the advantage of idioms within its resource files, for accurately translating specialized phrases from one language (and culture) to another*" (emphasis added). First, this is apparently unsupported conjecture attempting to state a motivation to justify the combination of Motoyama and Fukumochi. There must be some motivation to combine reference teachings and that must appear in the references or in the generally available knowledge (see e.g., MPEP §2142, quoted above). The Action here is simply

Docket No.: SA9-98-050 (12780.315)

Patent

silent with respect to the latter, thus failing, here as well, to fully state a prima facie case for obviousness. Second, the end benefit of this combination is asserted to be accurate translation, but that is irrelevant to claim 3. Accurate translation is not a benefit that claim 3 provides directly. If an inaccurate resource file is used the replacements made will similarly be inaccurate. Third, the combination as stated will not work. Motoyama teaches dictionaries (or dictionaries plural, or dictionaries with plural sections – but always something with plural definitions). Fukumochi teaches plural idioms. Without some set of rules to combine these, the results will be nonsensical. Present claim 3 does not need or have a rules element to pick from among plural idioms or definitions. Applying Motoyama and Fukumochi in the proposed manner would therefore be unsatisfactory for the intended purpose of the claimed invention, and there can be no suggestion or motivation to make a non-workable modification. See e.g., MPEP 2143.01 and the case law cited therein.

The Action continues:

Motoyama teaches markup based translation of Web pages (Motoyama column 4 lines 14-23, also Figure 3). Motoyama does not specifically teach said markup page as a "template". However, Lakritz teaches a multilingual translation method whereby tag based templates are utilized for content translation (Lakritz Abstract, also column 26 lines 47-60, column 5 lines 40-45, column 6 lines 50-65; compare with claim 3 "a markup-language encoded template"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Lakritz to Motoyama, providing Motoyama the benefit of templates which can easily support many languages and countries, as well as easy to add new languages, updating, etc. (see Lakritz column 7 lines 3-11).

With respect to the first sentence above, this is addressed by the remarks in the prior paragraph. With respect to the second and third sentences, we agree. However, since Lakritz also teaches translation, and dictionaries with multiple possible choices and "rules files" and "rulesets" to make this all work, whether Lakritz does or does not teach or reasonably suggest tag based templates is not determinative. What Lakritz, or any combination employing it, puts into its templates is irreconcilably different than what claim 3 uses.

All of Motoyama, Fukumochi, and Lakritz teach inventions for performing translation, specifically, explicit rules-based translation. The claimed invention does not perform translation; it replaces variables with previously translated data.

With regard to claims 5-6, we submit that these rejections are error for the same reasons as parent claim 3, discussed above.

Docket No.: SA9-98-050 (12780.315)

Patent

With regard to claim 11, the Action here largely restates what it already stated for claim 3. In the interest of brevity, we here note differences, discusses those, and otherwise incorporate by reference our already made remarks.

The 1st paragraph here is essentially the same as the 1st for claim 3. Other than “resource files containing data for replacing [a] variable” (claim 3, emphasis added) and “data files ... having therein a ... data portion ... to replace said variable” (claim 11, emphasis added), the same rationale for rejection are employed by the Action, and the same rationale why that is error apply.

Other than “claim 11” verses “claim 3” and omitting a parenthetical comment, the 2nd paragraph here is the same as the 3rd for claim 3.

The one new paragraph in the Action here (the 3rd for claim 11) states:

Motoyama teaches selection of a dictionary file used to construct a page using translated words from said dictionary file (Motoyama column 6 lines 20-25; compare with claim 11 “selecting one of said plurality of data files”, and “constructing an HTML encoded ... replace said variable”).

Respectfully, this is wrong. At col. 6, ln. 20-25 Motoyama does not teach selection of a dictionary file, it teaches selection of a situation-specific section (copier, scanner, printer, or general subject matter) within an English-Japanese/Japanese-English dictionary. In contrast, claim 11 recites “each of said data files having therein a different language data ...” (emphasis added). In claim 11 definitions are not selected, a data file is selected, and once one is selected the same data portion from it is always used to replace a template variable.

Other than stating “compare with claim 3 “a markup-language encoded template”” verses “compare with claim 11 “providing an HTML template to a server, said HTML template including at least one variable”” the 4th paragraph here is the same as the 4th for claim 3.

With regard to claims 16 and 18-20, we submit that these rejections are error for the same reasons as parent claim 11, discussed above.

With regard to claim 21, the Action here also largely restates what it already stated for claims 3 and 11. In the interest of brevity we here again note differences, discusses those, and otherwise incorporate by reference our already made remarks.

Docket No.: SA9-98-050 (12780.315)

Patent

The 1st paragraph here is largely the same as the 1st for claims 3 and 11. However, the Action here does additionally state "... (Motoyama column 4 lines 14-23, ...; compare with claim 21 *"a markup-language encoded...having a replacement variable..."*)" (emphasis added). Whereas, the cite to col. 4, ln. 14-23 appeared totally irrelevant to the argument above for claims 3 and 11, there is some arguable relevance here. Claim 21 recites *"a markup-language encoded template having a replacement variable within"* and it appears that the point being made in the Action here is that variable replacement in templates is taught by Motoyama. In general, we agree. However, claim 21 is here merely reciting a substantially conventional element that is used by its other particularly novel elements, and we have provided extensive remarks herein on why the rejection fails with respect to those elements.

Other than saying *"compare with claim 3 "a markup-language encoded template"* verses *"compare with claim 11 "providing an HTML template to a server, said HTML template including at least one variable"* verses *"compare with claim 21 "a markup-language encoded template"* the 2nd paragraph here is the same as 4th for claims 3 and 11.

The 3rd paragraph here appears to be a case of overzealous use of a word processor cut and paste function. This is essentially a repeat of the 1st paragraph here, for claim 21, and of the 1st for claims 3 and 11.

Other than *"claim 21"* verses *"claim 3,"* the 4th paragraph here is the same as the 2nd for claim 3.

Finally, other than *"claim 21"* verses *"claim 11"* verses *"claim 3"* and omitting the parenthetical for claim 3, the 5th paragraph here is the same as the 3rd for claim 3 and the 2nd for claim 11.

With regard to claim 22, we submit that this rejection is error for the same reasons as parent claim 21, discussed above.

Item 9 (§ 103(a) rejections, 2 of 4):

Claims 4 and 7-8 are rejected as being unpatentable (obvious) over Motoyama, Fukumochi, and Lakritz, and further in view of Levy. Respectfully this is error.

These claims depend from claim 3. As regards Motoyama, Fukumochi, and Lakritz, we have shown above that these do not teach all of the elements of claim 3, that no suggestion or motivation to combine them has been established, and that there is no reasonable expectation of

Docket No.: SA9-98-050 (12780.315)

Patent

success if their combination is used in place of the claimed invention. Levy does not remedy the deficiencies of these references.

It has never been argued that Levy teaches or reasonably suggests the elements that Motoyama, Fukumochi, and Lakritz are relied on for but fail to teach. In this respect the Action again fails to state a prima facie case for obviousness.

In regard to claim 4, the Action does state:

Motoyama does not specifically teach a language code. However, Levy teaches a country code, which is indicative of a particular language (Levy Abstract; compare with claim 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Levy to Motoyama, because of Levy's taught advantage of country codes, providing Motoyama with a way to process a particular language.

However, this is more misunderstanding or mischaracterization. Levy teaches a country code for the outright substitution of complete predefined pages when a different language is desired. This is not equivalent to Applicant's language code, which specifies selection of a resource file from which data is used to replace a replacement variable in a template. Accordingly, Levy does not even teach or reasonably suggest the one element that it is relied upon to justify the combination of references used for this rejection.

As for the conclusion stated here in the Action, this is apparently unsupported conjecture attempting to state a motivation to justify the combination with Levy. There must be some motivation to combine reference teachings and that must appear in the references or in the generally available knowledge (see e.g., MPEP §2142, quoted above).

Further, Levy's storing of static pages cannot properly be combined with Motoyama's, Fukumochi's, or Lakritz' dynamic translation approaches to construct an end result. Such a modification would clearly change the principles of operation of the prior art being combined. To employ the teachings of Levy to store already translated pages would change these references away from a translation tool entirely. Similarly, employing the teachings of these other references to translate a page, on the fly so to speak, would remove from Levy the very reason it uses complete pre-constructed pages. Levy and Motoyama/Fukumochi/Lakritz solve largely the same problem -- but in essentially opposite ways. Modifications or combinations of prior art that would change a principle of operation are not obvious. See e.g., MPEP 2143.01 and the case law cited therein.

Docket No.: SA9-98-050 (12780.315)

Patent

Furthermore, applying Motoyama/Fukumochi/Lakritz in combination with Levy in the proposed manner would still be unsatisfactory for the intended purpose of the claimed invention, because such a combination overlooks other elements such a combination would still be required to work. Motoyama, Fukumochi, and Lakritz are inoperable without rules to select definitions or idioms, and Levy merely substitutes entire web pages (and the claimed invention does no do either of these). There can be no suggestion or motivation to make a non-workable modification. See e.g., MPEP 2143.01 and the case law cited therein.

In regard to claim 7, the Action states:

Motoyama does not specifically teach server side processing. However, Levy teaches a server accepting a web request along with a country code for processing of said web page (Levy column 2 lines 32-46; compare with claim 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Levy to Motoyama, because of Levy's taught advantage of server side processing, providing Motoyama with a way to process a particular language freeing up client resources.

The cited portion of Levy merely describes that it stores its substitute web pages on a server. There is nothing taught or reasonably suggested here that has anything to do with "building" or "combining" anything. In contrast, claim 7 recites that "a constructed markup-language code is built at a server by combining said markup-language encoded template and data from said resource file."

In regard to claim 8, the Action relies on the rationale applied to claim 7, from which claim 8 depends. However, in addition to its failings with respect to claim 7, we note that Levy also does not teach or reasonably suggest what claim 8 recites, that a "server builds the constructed markup-language code by substituting said replacement variable with data from said resource file" (emphasis added).

Item 10 (§ 103(a) rejections, 3 of 4):

Claims 14-15 are rejected as being unpatentable (obvious) over Motoyama, Fukumochi, and Lakritz, and further in view of Levy. Respectfully this is error.

These claims depend from claim 11. As regards Motoyama, Fukumochi, and Lakritz, we have shown above that these do not teach all of the elements of claim 11, that no suggestion or motivation to combine them has been established, and that there is no reasonable expectation of

Docket No.: SA9-98-050 (12780.315)

Patent

success if their combination is used in place of the claimed invention. Levy does not remedy the deficiencies of these other references.

It has never been argued that Levy teaches or reasonably suggests the elements that Motoyama, Fukumochi, and Lakritz are relied on for but fail to teach. In this respect the Action again fails to state a prima facie case for obviousness.

In regard to claim 14, other than "*claim 14*" verses "*claim 4*," the first paragraph of the Action here is the same as for claim 4. Similarly, the second paragraph here is the same as for claim 7.

In regard to claim 15, the Action references the rationale for rejection applied to claim 14, from which claim 15 depends, and we accordingly also incorporate by reference our remarks from above about why this is error.

Item 11 (§ 103(a) rejections, 4 of 4):

Claims 9-10 and 12-13 are rejected as being unpatentable (obvious) over Motoyama, Fukumochi, and Lakritz, and further in view of Berg. Respectfully this is error.

In regard to claim 9, the Action states "*the use of Java code within HTML (i.e. JavaScript) is known in the web publishing art, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply Java code to HTML for the advantage of dynamic applets, etc.*" We agree. Let us move on.

The Action next states:

Motoyama does not specifically teach a JAR file containing a Java ResourceBundle. However, Berg teaches Java in association with a Hot Java browser, incorporating a JAR file and a Java ResourceBundle to be eventually run as an applet (Berg p.6 at numbers 5, 6, also p.7 at number 8; compare with claim 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Berg to Motoyama, because of Berg's taught advantage of JAR files and resource bundles, providing Motoyama with a way to utilize the advantages of said files for its dictionaries.

However, as discussed above, Motoyama's dictionaries are not equivalent to Applicant's data files, and any speculated advantages that might be provided by those are not relevant. The Action fails to look beyond the use of JAR files, which the present application concedes is prior art, and to look to the content of the JAR files here. We respectfully submit, that no prima facie case for obviousness has been stated here.

Docket No.: SA9-98-050 (12780.315)

Patent

In regard to claims 10 and 12-13, the Action references the rationale for rejection applied to claims from which these depend, and we accordingly also incorporate by reference our remarks from above about why this is error.

CONCLUSION

Applicant has endeavored to put this case into complete condition for allowance. It is thought that the §101 rejection has been corrected by amendment, and that the §103 rejections are shown to be unfounded on the prior art references cited or to have been completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

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